



AF/3767
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MS APPEAL BRIEF - PATENTS
0445-0295P

IN THE U.S. PATENT AND TRADEMARK OFFICE

#18 / appeal
Brief

In re application of Akira NODA et al.
Before the Board of Appeals
Appeal No.:
Appl. No.: 09/818,783 Group: 3767
Filed: March 28, 2001 Examiner: C. ANDERSON
For: ABSORBENT ARTICLE
Conf: 1034

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MS APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

July 28, 2003

Sir:

Transmitted herewith is an Appeal Brief (in triplicate) on behalf of the Appellants in connection with the above-identified application.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

A Notice of Appeal was filed on May 27, 2003.

☐ Applicant claims small entity status in accordance with 37 C.F.R. § 1.27

The fee has been calculated as shown below:

☐ Extension of time fee pursuant to 37 C.F.R. §§ 1.17 and 1.136(a) -

☒ Fee for filing an Appeal Brief - \$320.00 (large entity).

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Appl. No. 09/818,783

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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(Rev. 04/29/03)



PATENT
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BRIEF ON BEHALF OF APPELLANTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

July 28, 2003

Sir:

This Appeal Brief is respectfully submitted on behalf of the Appellants in connection with the above-identified application.

This is an Appeal from the Final Rejection of Claims 10 and 11 in the above-identified application, which claims were finally rejected in the Office Action dated February 24, 2003. The appealed claims 10 and 11 are set forth in the attached Appendix.

I. REAL PARTY IN INTEREST

In accordance with 37 C.F.R. § 1.192(c)(1), it is submitted that the real party in interest of the present application is the Assignee, Kao Corporation of Japan.

II. RELATED APPEALS AND INTERFERENCES

In accordance with 37 C.F.R. § 1.192(c)(2), it is submitted that there are no other appeals or interferences known to Appellants, the undersigned, or the Assignees that will directly affect or be directly affected by or have a bearing on the Board's decision in the present appeal.

III. STATUS OF THE CLAIMS

Claims 1-9 have been cancelled. Claims 10 and 11 have been finally rejected by the Examiner in connection with the above-identified application. Claims 10 and 11 are set forth in the attached Appendix.

IV. STATUS OF AMENDMENTS

An Amendment after Final Rejection was filed on October 29, 2002, which was denied entry as raising new issues according to the Advisory Action of November 19, 2002. However, entry of this Amendment was indicated in the Request for Continued Examination dated November 27, 2002. Apparently, this Amendment has been entered.

An Amendment dated May 27, 2003 was filed along with the Notice of Appeal. Although no action has been received from the Examiner in response to this, it is assumed that this Amendment has been entered since the application is not under final

rejection. Further, this Amendment merely cancelled claims and accordingly simplified the issues on appeal.

V. SUMMARY OF THE INVENTION

The present invention is a disposable diaper having printing placed thereon, especially on the back of the diaper, as shown in Figure 1. The diaper is made in layers, as shown in Figure 2B. A liquid permeable topsheet 2 is adjacent the skin. A liquid retentive absorbent layer 4 lies below the top sheet and on top of a back sheet 3. The back sheet is made of three layers, including a breathable film 3A and two non-woven material layers 3B and 3C. The printing is placed on the outer surface of breathable film 3A. Thus, the printing must be visible through the two non-woven material layers 3B and 3C. In order for the printing to be viewed clearly, the film and non-woven material must fall into certain ranges of parameters. In particular, the parameters of the colorimetric system are utilized. These include the L* value which measures lightness, the C* value which represents chroma and the b* value which represents whiteness are utilized. The non-woven material also must have parameters which fall into certain ranges, including a light transmittance of 40-83% and a basis weight of 30-45g/m². When the parameters fall within the ranges of values as claimed, not only is the printing particularly visible, but also the diaper retains a soft feeling, which is also important for consumers.

VI. ISSUES

1. Whether claim 10 is unpatentable under 35 USC §103 as being obvious over Tao et al (WO 99/60973) in view of Morman et al (US 5,883,028).

2. Whether claim 11 is unpatentable over 35 USC §103 as being obvious over Tao et al in view of Morman et al as applied in claim 10 and further in view of McCormack (WO 00/38915).

VII. GROUPING OF CLAIMS

It is submitted that the presently appealed claims should be considered separately in the following 2 groups:

Group I: Claim 10;

Group II: Claim 11;

Claim 10 is the only claim involved in the first issue. Claim 11 is the only claim involved with the second issue. Thus, each claim forms a separate group and they do not stand or fall together.

VIII. APPELLANTS' ARGUMENTS

1. Whether claim 10 is unpatentable under 35 USC §103 as being obvious over Tao et al (WO 99/60973) in view of Morman et al (US 5,883,028).

The Examiner rejected claim 10 as being obvious over Tao et al in view of Morman et al. The Examiner states that Tao et al shows an absorbent article having a liquid permeable topsheet 54, an absorbent core 66, and a liquid impermeable backsheet 52. The backsheet has a breathable film material with a nonwoven material laminated on the outer side. Printing is applied in colors. The Examiner further points out that Tao et al discloses performing color difference tests and having a preferred value of b^* between 0.0 and 0.5.

However, even if Tao et al does disclose this structure which is similar, it does not disclose the range parameters for L^* , C^* , b^* , the light transmittance and the basis weight of the nonwoven material. The Examiner believes that these ranges of parameters would be obvious to one of ordinary skill in the art. Applicants disagree that these ranges would be obvious. There is no disclosure or even hint that these ranges of parameters are important in the Tao et al reference. The Examiner relies on some generalities about printing to indicate that the ranges would be obvious. However, Applicants submit that the Examiner is using hindsight in order to reconstruct the present invention. In regard to the lightness value, L^* , the Examiner merely states that having colors such as royal blue falls near the center of

the range. However, the parameter L^* measures the lightness or darkness of a color, not the color itself. Even though royal blue is a medium blue color, it can still be very faded or very dark and does not necessarily fall within the given range. Furthermore, the Tao et al reference does not even consider the usefulness of this color in terms of lightness or darkness. Accordingly, the particular range of lightness is not hinted at in the reference.

Secondly, Tao et al does not disclose a value for chroma or C^* . The Examiner argues that having a value within the given range of 20-120 would be necessary in order to produce a clear and visible graphic. However, there is no statement of this in the reference and there is no teaching that this particular value would produce a clear and visible graphic. Applicants submit that the Examiner has inserted qualities into the cited article which are not present and which are not even hinted at.

In regard to the light transmittance of the nonwoven material, the Examiner merely states that the material must have suitable light transmittance to avoid hindering the visibility of the printed design. However, the range of light transmittance is given as 40-83%. Certainly if visibility were the only concern, the light transmittance would extend to 100%. However, since other qualities are desirable, such as feel to the touch, having a nonwoven material in this range would not be obvious merely on the basis of an argument of being able to see the printing.

Also, the background area on the film is defined as having a b^* value of 0 to -5. This parameter is discussed in Tao et al, but the values given are specifically between 0 and +0.5. Accordingly, the ranges are different and overlap only at the single point of 0.

Accordingly, Tao et al does not describe the ranges of parametric values for L^* , C^* , b^* and light transmittance as described in the final three paragraphs in claim 10. Applicants submit that the Examiner's arguments based on generalities regarding colors do not render these ranges of parameters obvious. In fact, in some cases, the obvious conclusion would be to have a different range of values.

It should be remembered that these ranges of values are based not only on the ability to see the printing, but also for the product to have other qualities, including a soft feel. Having values which permit the best printing may affect other qualities so that the parameter values should not be based on this decision alone. Apparently, these ranges and values would not be obvious merely on arguments related to the printing.

Thus, the Examiner has admitted that the Tao et al reference remains silent as to these parameters. The Examiner also admits that the reference does not disclose performing color difference tests on the printed area. The Examiner's reliance on

generalized arguments concerning the parameters does not satisfy any requirements for motivation for selecting this range of values. As discussed in the present specification, the combination of the range of values of these parameters yields products that have suitable attributes not only for visibility of printing but also for other purposes. Since the prior art does not in anyway discuss these other attributes, the selection of the particular ranges is not at all obvious.

The Examiner also admits that the Tao et al reference remains silent as to the basis weight of the nonwoven material. The Examiner cites the Morman et al reference to show a basis weight of 15-50 g/m² in column 11, lines 44-46.

Applicants agree that this reference discusses a material having a basis weight of 10-75, preferably 15-50 and most preferably 20-40 g/sm², as noted at column 11, lines 45-47. However, Applicants disagree with the Examiner that this is the nonwoven material being referred to. Instead, this is referring to a meltblown web which is an additional layer which may be added in this embodiment to the breathable elastic film before being laminated to the neckable web, as noted in column 11, lines 35-37. It is the neckable web which corresponds most closely to the nonwoven material of the present claims. This is indicated for example at column 2, line 8 where the web is referred to as a "necked nonwoven web". Further, it is noted that at column 11, lines 58-61, the laminate formed is described as three layers

"elastic meltblown web/elastic film/necked spunbond web." Thus, the melt blown web which has the given basis weight is not the same as the necked web. Accordingly, the Examiner has misread the reference and attributed the given basis weight to the wrong material. Accordingly, Applicants submit that the Morman et al reference does not teach the feature suggested by the Examiner. Accordingly, since the Morman et al reference does not teach the basis weight as claimed and since Tao et al does not teach this feature either, as admitted by the Examiner, Applicants submit that the claim is allowable since neither reference shows this feature and since it would not be obvious thereover in view of either of these references or their combination.

2. Whether claim 11 is unpatentable over 35 USC §103 as being obvious over Tao et al in view of Morman et al as applied in claim 10 and further in view of McCormack (WO 00/38915).

Claim 11 was separately rejected over a three-way combination of references, including the two references discussed above and further in view of McCormack et al. The Examiner admits that the Tao et al reference does not teach a range of values of b^* less than 0 and greater than or equal to -5. The Examiner cites the McCormack et al reference to show a film having a b^* value of -0.2 disclosed on page 22, lines 27-29.

First, Applicants submit that claim 11 is allowable based on dependency from allowable claim 10. Further, Applicants point to the Examiner's admission that the Tao et al reference does not show a value of b^* as claimed in claim 11. Further, Applicants

submit that it would not be obvious to add the teachings of the McCormack et al reference to those of the primary and secondary references. Applicants submit that there is no teaching of a motivation or the need to change this value of b^* to that indicated in McCormack et al. The only reason given in the McCormack et al reference as to the importance of this value is that it helps to hide the yellow color through the film. Applicants invention does not utilize this b^* value to hide yellow, but instead utilizes this range of values to provide proper whiteness for allowing the printing to be clearly visible and to provide other properties. Applicants do not utilize such a value in order to hide the yellow tint.

Furthermore, Applicants submit that there is no teaching of motivation for utilizing this particular film in the combined Tao et al and Morman et al device. The reason for the McCormack et al value b^* is to hide yellow tints. Since there is no reason to hide such a tint in the Tao et al and Morman et al references, it would not be obvious to add this feature to the other two references. For these additional reasons, Applicants submit that claim 11 is also allowable.

IX. CONCLUSION

In view of the above, Applicants submit that the Examiner's final rejection is erroneous and that claims 10 and 11 are allowable. Accordingly, reversal of the Examiner's decision is respectfully requested.

The required Appeal Brief Fee in the amount of \$320.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Appendix - Claims Appealed

APPENDIX A

CLAIMS APPEALED

10. An absorbent article comprising a liquid-permeable topsheet, a liquid-impermeable backsheet, and a liquid retentive absorbent member interposed between the topsheet and the backsheet, wherein

said backsheet comprises a laminated sheet composed of a breathable film printed with a multicolor pattern and a nonwoven material, the nonwoven material being superposed on the printed side of said film,

the printed area of said film has an L* value of 10 to 93 and a C* value of 20 to 120 as measured with a color difference meter,

said nonwoven material has a light transmittance of 40 to 83% and a basis weight of 30 to 45 g/m²; and

nonprinted background areas on the printed side of said breathable film have a b* value of 0 to -5.

11. The absorbent article according to claim 10, wherein said b* value is less than 0 and greater than or equal to -5.